

REMARKS

Entry of the foregoing, and further examination and reconsideration of the subject application, in view of the amendments above and the remarks below, are respectfully requested.

Status of Claims

By the above amendments, non-elected claims 43-45 have been canceled without prejudice or disclaimer. Claim 27 was previously canceled. No claims are currently amended. Thus, upon entry of the foregoing amendments, claims 1-26 and 28-42 will remain pending in the application. Each of these claims is under consideration.

Oath/Declaration

In the Office Action, the Examiner requested a copy of the oath/declaration. Enclosed herewith is a copy of the declaration submitted in parent Application No. 10/107,674.

Claim Rejections – 35 U.S.C. §§ 102/103

Claims 1-4, 7-10, 12, 15-20, 31-37, 39-40, and 42 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,106,944 to Sublett ("Sublett"). Claims 1-4, 7-10, 12, 15-20, 31-37, 39-40, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sublett in view of U.S. Patent No. 5,922,816 to Hamilton ("Hamilton") or Smith et al., "Chemistry of Miscible Polycarbonate-Copolyester Blends," *J. Applied Polymer Sci.*, Vol. 26, 4233-4245 (1981) ("Smith"). Claims 1-10, 12-20, 31-40, and 42 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sublett in view of U.S. Patent No. 5,254,610 to Small, Jr. et al. ("Small") optionally in further view of Hamilton or Smith. For the following reasons, these rejection should be withdrawn.

Sublett does not disclose or suggest each feature of the present invention, as set forth in representative claim 1. For example, Sublett fails to disclose or suggest a

polyester-polycarbonate blend where the polyester is prepared in the presence of a titanium catalyst in an amount of about 1-30 ppm elemental Ti.

In contrast to the present invention, Sublett discloses using a catalyst system comprising a complex of titanium alkoxide with an alkali or alkaline earth metal salt where the titanium is present in an amount of 10-100 ppm. While there is overlap between Applicants' claimed range and Sublett's range, Applicants' claimed range can provide blends with reduced yellowness and increased thermal and melt stability, which are neither taught nor suggested by Sublett. See Examples 1-4 and Tables 2-4 in the instant application.

The Examiner, however, criticizes the data as not being a comparison with the closest prior art of Sublett. According to the Examiner, the data is not convincing because it does not include a comparison with a catalyst containing an alkali/alkaline earth metal called for by Sublett. *Final Office Action* at 5. The Examiner's position, however, is untenable because Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the Examiner. See MPEP § 716.02(e)(I) at 700-272 (citing *In re Holladay*, 584 F.2d 384 (CCPA 1978) and *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961)).

In this case, the comparative blends are more closely related to the claimed invention than the Sublett composition. In Examples 1-4, the only significant difference in the blends is the Ti concentration. Polyesters 1 and 3 have Ti concentrations outside the claimed range, while Polyesters 2 and 4 have Ti concentrations within the claimed range. On the other hand, the polyester of Sublett further differs from Polyesters 2 and 4 of the claimed invention by additionally using an alkali or alkaline earth metal salt. Since Polyesters 1 and 3 are closer to Polyesters 2 and 4 of the claimed invention than the polyester of Sublett, the comparative data in Tables 2-4 can be used to show unexpected results of the claimed invention.

With regard to secondary references Hamilton and Smith, we agree with the Examiner that they both discuss the negative effects of residual polyester catalysts. However, Applicants disagree with the Examiner's conclusion drawn from these references. The Examiner alleges that to minimize these problems, persons skilled in the art would choose lower amounts of catalyst when producing the polyester.

However, as both Hamilton and Smith demonstrate, that's not a choice that persons skilled in the art would have made. Rather than minimizing the amount of catalysts, Hamilton teaches using a silyl phosphate to deactivate the catalyst. Similarly, Smith discloses using a complexing agent to deactivate the catalyst. Thus, Hamilton and Smith cannot be relied upon to suggest using low amounts of titanium catalyst. Even if they could be, the data in Tables 2-4 of the instant application, as discussed above, rebut any *prima facie* case of obviousness.

With regard to the other secondary reference Small, it was only cited in connection with the use of phosphates. It does not remedy the deficiencies of Sublett discussed above.

For the foregoing reasons, the rejections based on Sublett, Hamilton, Smith, and Small should be withdrawn.

Claims 1-13, 15-26, 28-37, and 39-42 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,786,692 to Allen et al. ("Allen") in view of U.S. Patent No. 5,886,133 to Hilbert et al. ("Hilbert"). For the following reasons, this rejection should also be withdrawn.

Allen does not disclose or suggest each feature of the present invention, as set forth in representative claim 1. For example, Allen fails to disclose or suggest a polyester-polycarbonate blend where the polyester is prepared in the presence of a titanium catalyst in an amount of about 1-30 ppm elemental Ti. In fact, no amount of Ti catalyst is mentioned at all.

To remedy the deficiency of Allen, the Office Action relies on Hilbert. But Hilbert cannot be properly combined with Allen because there is no suggestion or motivation to combine their respective teachings. As noted in Applicants' prior response, Allen is directed to a blend of an aromatic polycarbonate and an amorphous copolyester. Col. 3, lines 50-53; col. 5, lines 7-11. On the other hand, Hilbert is directed to a process for preparing crystalline polyethylene terephthalate (PET). Col. 3, lines 35-37. Amorphous polymers are recognized in the art to be different from crystalline polymers, with different properties. For example, amorphous polymers are known for their transparency, while crystalline polymers are known for their strength. See Alger,

Polymer Science Dictionary, 18, 95 (1989) (copy attached). Since Allen and Hilbert are directed to different kinds of polyesters, one skilled in the art looking to modify Allen would not have drawn upon the teachings of Hilbert. Rather, such persons would have looked to more closely related art in the field of amorphous polyesters.

In the final Office Action, the Examiner dismisses this distinction, saying that Hilbert “makes the same polyester as called for by Allen”. But as discussed above, Hilbert does not make the “same polyester” as Allen. Hilbert makes a crystalline polyester, while Allen makes an amorphous one. Even though the polyester of Hilbert can contain components common to the polyester of Allen, their proportions are different. For example, in Allen, the ethylene glycol (EG) content ranges from 20 to 80 mole% (col. 4, lines 25-28), while the EG content in Hilbert must be at least 65 mole% (col. 2, lines 47-48). Thus, it would not have been readily apparent to persons skilled in the art that the method of making polyesters in Hilbert would be applicable to making the polyesters of Allen.

Even if Hilbert could properly be combined with Allen, any *prima facie* case of obviousness based on these references has been rebutted by the unexpected results shown in Examples 1-4 and Tables 2-4 of the instant application and discussed above.

Accordingly, for the foregoing reasons, the rejection based on Allen and Hilbert should be withdrawn.

Claim Rejection – Obviousness Double Patenting

Claims 1-26 and 28-42 also stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of U.S. Patent No. 6,723,768. In response to this rejection, Applicants filed a terminal disclaimer on August 16, 2005, but it was not accepted because the disclaimer was not signed by an authorized representative. Applicants are now resubmitting a terminal disclaimer signed by the undersigned, who is an authorized representative. Accordingly, the rejection is now moot, and should be withdrawn.

Conclusion

In summary, Applicants believe the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Heidi J. Dumble

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Date